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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/711,481	09/21/2004	James W. Taylor	JD-347	5480
54308	7590	12/26/2007		
BASF AG CARL-BOSCH-STRASSE 38 6700 LUDWIGSHAFEN RHEINLAND-PFATZ D-67056, 67056 GERMANY			EXAMINER YOON, TAE H	
			ART UNIT 1796	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/711,481	Applicant(s) TAYLOR ET AL.	
	Examiner Tae H. Yoon	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 24-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's election without traverse of Group I in the reply filed on November 1, 2007 is acknowledged. Applicant further elected "acids" for a water-borne polymer and "carboxy" for a stabilizing agent. Thus, claims 1-23 (claim 15 would fall under generic claim 1 also) are examined under merit. The restriction requirement is made FINAL.

Prior art of PTO-1449 without a publication year (or date) have not been considered.

The abbreviated "SBR" in claim 3 is objected and a full chemical name is needed.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-10, 13-21 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB (1,337,983).

GB teaches the instant generic composition comprising styrene-butadiene latex, ammonium zirconyl carbonate and ammonium tartrate in example VII. Other stabilizers are taught at pages 1 and 2. Amounts of components used in said example VII would meet the instant amounts inherently, and sodium salt and sodium hydroxide would meet the instant buffering agent as well. Other polymers such as polyacrylic acid is taught at page 1, line 19.

Thus, the instant invention lacks novelty.

Claims 1-23 are rejected under 35 U.S.C. 103(a) as obvious over GB (1,337,983) in view of Estes (US 5,661,208) and/or Gebhard et al (US 6,846,867)..

The instant invention further recites acrylic/styrene polymer, acid number of a polymer and non-ionic surfactant over Demko et al. However, Estes teaches the instant copolymer such as JONCRYL acrylic/styrene copolymers and various acid numbers at col. 6. Gebhard et al teach aqueous coating composition comprising methacrylic acid copolymer and non-ionic surfactant such as TERGITOL or TRITON and their advantage over phosphate surfactant in table 3.1.

It would have been obvious to one skilled in the art at the time of invention to employ an acrylic/styrene polymer or a polymer having an acid number of Estes in the composition of GB since GB teaches employing various polymers for coating and since use of an acrylic/styrene polymer or a polymer having an acid number is well known in the art as taught by Estes, and/or to utilize a non-ionic surfactant of Gebhard et al in GB

since Gebhard et al teach an advantage (better dispersion of particles) of said non ionic surfactant over phosphate surfactant in example VII of GB absent showing otherwise.

Claims 1-4, 7-14, 16-20 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Demko et al (US 4,018,959) and GB (1,337,983).

Demko et al teach an adhesive composition comprising a water dispersible polymer and an acidic salt in abstract. Said polymer comprises various monomers including acrylic acid (col. 3, lines 8-41), and the instant metal crosslinkers are also taught at col. 4, lines 29-68.

The instant invention further recites stabilizers and ammonium zirconyl carbonate over Demko et al. However, GB teaches that an advantage (stabilized viscosity) of employing a stabilizer in a metal salt composition in examples. GB also teach said ammonium zirconyl carbonate.

It would have been obvious to one skilled in the art at the time of invention to employ a stabilizer such as ammonium tartrate of GB in the composition of Demko et al in order to improve storage stability (self life) since such property is one of desired properties for adhesive composition.

Claims 1-20, 22 and 23 are rejected under 35 U.S.C. 103(a) as obvious over Demko et al (US 4,018,959) and GB (1,337,983), and further in view of Estes (US 5,661,208) and/or Gebhard et al (US 6,846,867)..

The instant invention further recites acrylic/styrene polymer, acid number of a polymer and non-ionic surfactant over Demko et al and GB.

It would have been obvious to one skilled in the art at the time of invention to employ a stabilizer such as ammonium tartrate of GB in the composition of Demko et al in order to improve storage stability (self life) since such property is one of desired properties for adhesive composition. Estes teaches the instant copolymer such as JONCRYL acrylic/styrene copolymers and various acid numbers at col. 6. Gebhard et al teach aqueous coating composition comprising methacrylic acid copolymer and non-ionic surfactant such as TERGITOL or TRITON and their advantage over phosphate surfactant in table 3.1.

It would have been obvious to one skilled in the art at the time of invention to employ an acrylic/styrene polymer or a polymer having an acid number of Estes in the composition of Demko et al and GB thereof since Demko et al teach employing various polymers for coating and since use of an acrylic/styrene polymer or a polymer having an acid number is well known in the art as taught by Estes, and/or to utilize a non-ionic surfactant of Gebhard et al in Demko et al and GB thereof since Gebhard et al teach an advantage (better dispersion of particles) of said non ionic surfactant over phosphate surfactant in example VII of GB and since utilization of surfactant in a coating composition containing solid particles such as caly of Demko et al is well known practice also partially evidenced by GB absent showing otherwise.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20, 22 and 23 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8, 20, 21 and 25-28 of copending Application No. 11/230,114 (US Pub. 2006/0063868). Although the conflicting claims are not identical, they are not patentably distinct from each other because an amount of a stabilizing agent in said copending application encompasses that of the instant invention and since use of a nonionic surfactant would be an obvious modification to one skilled in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Tae H Yoon
Primary Examiner
Art Unit 1796

THY/December 20, 2007